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09/625,745

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Albert Henricus Franciscus de Heer

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10/10/2006

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EXAMINER

AL HASHEMI, SANA A

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,745

Applicant(s)

DE HEER ET AL.

Examiner

Sana Al-Hashemi

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 29-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 29-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is issued in response to applicant election of Group I claims 1-26, and 29-35 filed 6/30/06.
2. Claims 1-26, 29-35 are pending, 27-28, 36-55 are withdrawn from consideration. No claims were added. None were canceled.
3. Applicant's arguments filed 6/30/06 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24, 29 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language is not clear to whether the method of capturing data for use in a catalog is indented use and doesn't carry patentable weight. Specifically the claims is not clear in whether the captured information is to create, update, or to be added to an existing catalog

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since the claims merely mentions the use of the captured information “for use in a catalog”. The claims discloses system SKU, manufacturer SKU, and a customer SKU, identifying a product in and the customer SKU U is assigned by the customer, and the customer being a manufacturer, it’s unclear to the examiner if the customer is the manufacturer will the customer SKU and the manufacturer SKU are the same or different, if they are the same how the previous limitation “manufacturer SKU associated with the product within the product data system” can be performed and how the customer can assign the SKU if the customer is the manufacturer. Now if the customer and the manufacturer is different how the claim defined the customer to be a manufacturer. The other issue if the information is been captured “for use in a catalog” how the customer can request customized distribution of product data for a particular product, or will the product have more than one product information depending on the customer, because for a sue in a catalog the product should disclose all the information related to that specific product. On the limitation of “ a link to product information characterizing the product”. It’s unclear to the examiner on where this link is located and how it links the product information and it link the product information to what?

With respect to the customer identifier is this identifier is the SKU or different identifier and if the customer is a manufacturer will the customer identifier be a manufacturer identifier and will the information have been captured “for use in a catalog” based on the customer the data will be distributed to?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. the It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Prior to focusing on specific statutory requirements, Office personnel must begin examination by determining what, precisely, the applicant has invented and is seeking to patent, and how the claims relate to and define that invention. (As the courts have repeatedly reminded the Office: "The goal is to answer the question What did applicants invent?" In re Abele, 684 F.2d 902, 907, 214 USPQ 682, 687. Accord, e.g., Arrhythmia Research Tech. v. Corazonix Corp., 958 F.2d 1053, 1059, 22 USPQ2d 1033, 1038 (Fed. Cir. 1992).) Consequently, Office personnel will no longer begin examination by determining if a claim recites a "mathematical algorithm." Rather they will review the complete specification, including the detailed

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description of the invention, any specific embodiments that have been disclosed, the claims and any specific, substantial, and credible utilities that have been asserted for the invention.

A. Identify and Understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer- readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Although the courts have yet to define the terms useful, concrete, and tangible in the context of the practical application requirement for purposes of these guidelines, the following examples illustrate claimed inventions that have a practical application because they produce useful, concrete, and tangible result:

In the instant application

Regarding Claims 1, 22-25, the claimed sequence of steps of data processing has no tangible, useful, and concrete results to the processed data.

No art has been applied to reject claims 1-24 due the 112 and 101 rejection at this point.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, and 26 are rejected under 35 U.S.C 102(b) as being anticipated by King Jr. et al. (King hereinafter) (US Patent No. 5,319,542 issued June 7, 1994)

Regarding Claim 25, King discloses a method of capturing data for use in a catalog comprising;

creating a customer product portfolio file that identifies products for which a customer requests that data be captured (col. 3, lines 52-58, King, wherein the method of creating a private catalog for each customer corresponds to the step of creating a customer product portfolio);

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mapping the customer product portfolio file to a system product data file to identify products in the product portfolio file that are not in the system (Col. 4, lines 15-30, King, wherein the method of downloading the product information from a master catalog to private catalog corresponds to the step of mapping the customer product portfolio file to a system product data file to identify products in the product portfolio file that are not in the system);

capturing data for the product portfolio that is not in the system (Col. 4, lines 34-46, King, wherein the method of maintaining and updating the private catalog corresponds to the step of capturing data for the product portfolio that is not in the system, since the update will add new product information that was not in the private catalog before); and

adding the captured data to the system product data file (Col. 4, lines 40-43, King, wherein the update will add new product information that was not in the private catalog before).

Regarding Claim 26, King discloses a method of capturing data of claim 25, further comprising:

requesting components of the added system product data file be transmitted to the customer thereby allowing the customer to acquire and build a customized catalog based on products in the system product data file (Col. 4, lines 47-59, King).

Response to Arguments with respect to the Restriction Requirements

Applicant's election with traverse of Group I in the reply filed on 2/9/06 is acknowledged.

This is not found persuasive because

Applicant argues that the response to election requirement filed 2/9/06 "in response to the species election requirement set forth in the Office Action mailed January 9, 2006, Applicants hereby elect Species 1, claims 1-26, and 29-35 drawn to Figure 8B. In addition, the Applicants respectfully request reconsideration of the Examiner's Election Requirement, at least with respect to Species 111 and IV. In particular, the Applicants note that 111 consideration and examination of elected Species I would necessarily encompass the invention of Species 111 and IV. For instance, dependent claims 6, 8 and 9 of the elected Species I recite creating a product header that is associated with the product, this feature being the basis for the claims of non-elected Species 111 and Species IV. Correspondingly, because Species 111 and IV can be examined together with Species I without serious burden to the Examiner, the Applicants request examination of these species as well."

Examiner disagrees. The claimed invention in claim 1 deals with capturing product data by associating a manufacturer/ customer SKU, linking the product information characterizing the product and distributing the captured data along with customer identifier. In Claims 36, and 50, the data captured based on classes and these classes are defined by one or more categories, which is completely distinct from the method of associating a SKU to a product data. with respect to applicant argument regarding dependent claims 6, 8, and 9, the dependent claims inherent all the limitation of the claim they depend from there fore the claims are distinct for the reason stated above.

The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

Applicant argues that “present claims 1-56 comply with the requirement of 35 U.S.C. § 112, second paragraph”.

Examiner disagrees. As stated in this office action under 35 U.S.C. § 112, second paragraph rejection that the none of the issues raised as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention have been clarified, Applicant stated in the responds filed 6/30/06, “the specification is replete with examples of customer SKU numbers related to customer. Customer may be manufacturer, distributors and reseller “. This responds did not answer the issue raised in the previous office action of “ if the customer may be a manufacture would the SKU number be the same number or different number” and as a clarification the claims were rejected under 112 2nd as being indefinite not 112 1st for lack of support in the specification.

Applicant argues that the”With respect, Applicants submit that the present claims 1-56 comply with the requirements of 35 U.S.C. § 101 by producing a useful, concrete, and tangible result. For example, claim 1 recites a method of capturing data for use in a catalog. The captured is useful: it can be used to order items from a catalog. It is tangible and concrete; the captured data is stored in a product data system. With respect, there is insufficient information with which to determine the criteria the Examiner bases the rejection under 35 U.S.C. § 101. As such, Applicant request reconsideration of the rejection under U.S.C. §101 and withdrawal of the rejection in the present application”.

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Examiner disagrees. There is no tangible, useful and concrete results accomplished at the end of the process the system does capture, associated and link information, however the claims is not clear to whether display or store or post the result of the process. In other words there is no results other than the sequence of steps and specific method of identifying data. Therefore the 101 is believed to be proper. Therefore the 101 and 112 rejection are maintained and finalized.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sana Al-Hashemi whose telephone number is 571-272-4013. The examiner can normally be reached on 8Am-4:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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